



11 JAN 2006

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In re Application of
BENNETT et al.
Application No.: 10/519,729
PCT No.: PCT/NZ03/00136
Int. Filing Date: 30 June 2003
Priority Date: 28 June 2002
Attorney Docket No.: 31036.401USPC
For: UTILITY USAGE EVALUATION SYSTEM
AND METHOD

DECISION

This is a decision on applicants' petition under 37 CFR 1.47(a) filed 27 October 2005 in the United States Patent and Trademark Office (USPTO).

BACKGROUND

On 30 June 2003, applicants filed international application PCT/NZ03/00136, which designated the United States and claimed a priority date of 28 June 2002. A copy of the international application was communicated from the International Bureau to the USPTO on 08 January 2004. The thirty-month period for paying the basic national fee in the United States expired at midnight on 28 December 2004.

On 28 December 2004, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee, the surcharge under 37 CFR 1.492(e) for providing the oath or declaration later than thirty months from the priority date were required, and an assertion of small entity status.

On 27 June 2005, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b).

On 27 October 2005, applicants filed the instant petition under 37 CFR 1.47(a) which was accompanied by, *inter alia*, a petition/fee for a two-month extension of time, a declaration of inventors, a declaration of facts by Geoffrey William Bennett, a declaration of facts by Bruce Kerr, and a declaration of facts by Craig Morison.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17(h); (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the missing inventor; and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

Items (1), (3), and (4) have been satisfied.


Item (2) has not been satisfied. The declarations of facts and the supporting exhibits have been considered. However, to establish a refusal to sign, it is required that the non-signing inventor be presented with the application papers (specification, including claims, drawings, and oath or declaration). See MPEP 409.03(d). While the declarations of facts indicate that the non-signing inventor was presented with a declaration of inventors, it is not clear that he was presented with the specification. "It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. *In re Gray*, 115 USPQ 80 (Comm'r Pat. 1956)." MPEP 409.03(d). Additionally, there does not appear to have been an express refusal by Mr. Sheppard. When "it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition." MPEP § 409.03(c), Item II. Here, however, it is not clear what Mr. Sheppard's response was either time that he was presented with the declaration of inventors.

CONCLUSION

For the above reasons, applicants' petition under 37 CFR 1.47(a) is **DISMISSED**, without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. **Failure to timely file the proper response will result in abandonment of this application.** Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)". No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.


Daniel Stemmer
Legal Examiner

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